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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/988,155
Filing Date: November 19, 2001
Appellant(s): SINI, JEAN

Siddhesh V. Pandit
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 11, 2008 appealing from the Office action mailed April 17, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0107755 A1	STEED	8-2002
2002/0010715 A1	CHINN	1-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 10 and 19 recite “the entered information”, “stored information” and “received at least one selection of information”. The scope of the claims can not be determined because it is not clear which information to be stored and entered from the user of the mobile device.

Furthermore, it is unclear what includes the “indication from a user.” Further, it is difficult to determine what if anything happens as a result of the user providing “an indication.” Still further, the claim language is indefinite because it is unclear what exactly the mobile device is doing as reflected in the claim limitation “a mobile device to do so.”

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steed et al. (US Pub. No. 2002/0107755) of record in view of Chinn et al. (US Pub. 2002/0010715 A1) of record.

Regarding claims 1, 10 and 19, Steed discloses a method for automatically entering information into form fields (abstract of Steed) comprising the steps of:

- invoking a application program in response to an indication from a user of a mobile device to do so (see abstract and summary of Steed);
- scanning content transmitted from the application program to the mobile device to find a form having at least one field into which information is to entered (see ¶ [0008]; ¶ [0012]; ¶ [0013]; ¶ [0031] to ¶ [0039] and ¶ [0043]);
- retrieving and entering information to enter into the at least one field (see [0023] to [0026] and [0044], Steed) and transmitting the form including the entered information to the mobile device for display to the user (¶ [0008]; ¶ [0012]; ¶ [0026]; ¶ [0031] to ¶ [0039] and ¶ [0043]), the mapping for the form ([0009]);

Steed, however, does not explicitly disclose creating a mapping for the form. Chinn, on the other hand, discloses a method for browsing using a limited display device including creating a mapping for a form (summary and ¶ [0113], Chinn). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Steed to include the claimed feature as taught by Chinn. The motivation of doing so would have been desirable to efficiently access content stored on communication networks using limited display devices (¶ [0005], Chinn).

Regarding claims 2, 11 and 20, Steed/Chinn combination further discloses the receiving at least one edit made by the user of the mobile device of the entered information; and

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transmitting the form including the edited entered information to the application program (see ¶ [0013] and ¶ [0026], Steed). Further, it is inherent for a computer navigator to offer a user the ability to easily edit a display on screen. This ability has in large been the driving force behind the almost universal adoption of the computer as the preferred means of data entry via filling out a form.

Regarding claims 3, 12 and 21, Steed/Chinn combination further discloses the mapping for the form comprises information mapping at least one field of the form into which information is to be entered to stored information (see ¶ [0009], Steed).

Regarding claims 5, 14 and 23, Steed/Chinn combination further discloses the updating information mapping at least one field of the form into which information is to be entered to stored information based on the received selection of information made by the user, if the entered information was edited by the user (see ¶ [0021] and ¶ [0022], Steed).

Regarding claims 28-30, Steed/Chinn combination discloses wherein the information retrieved to enter into the at least one field of the form is stored in a location specifically associated with the form and the field (see ¶ [0044], Steed).

(10) Response to Argument

I. Examiner's response to Appellant's argument I: The rejections under 35 U.S.C. §112.

Applicant's arguments regarding the rejections under 35 U.S.C. §112 have been fully considered but they are not persuasive. In particular, it is unclear what includes the "indication from a user." Further, it is difficult to determine what if anything happens as a result of the user providing "an indication." Still further, the claim language is indefinite because it is unclear

what exactly the mobile device is doing as reflected in the claim limitation “a mobile device to do so.” Therefore, examiner maintains the 112 rejection of claims 1-3, 5, 10-12, 14, 19-21, 23 and 28-30.

II. **Examiner’s response to Appellant’s argument II: The rejections under 35 U.S.C. § 103.**

Appellant argues: “Steed is completely silent at least with regard to the creation of a mapping based on the at least one selection of information by a user.” (Appellant’s 6/11/08 Brief, pages 10-11).

Examiner respectfully disagrees.

Steed clearly discloses the mapping the fields of the forms ([0009] and [0023]) based on the merchant and user details information and automatically fill-in the form (abstract; summary and ¶[0012]). Therefore, this teaching still reads on the claimed limitation of “a mapping for the form based on the information received selection of information for the form” and it is inherently specifies how to fill-in fields in the form. Examiner maintains Steed’s teaching of mapping the fields of the forms in a manner similar to the applicant’s claimed language.

Appellant argues: “there is no teaching or suggestion that Chinn creates a mapping for the form...” (Appellant’s 6/11/08 Brief, pages 11-12).

Examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Steed discloses a method for automatically entering information into form fields (abstract of Steed) comprising the steps of: invoking a application program in response to an indication from a user of a mobile device to do so (see abstract and summary of Steed); scanning content transmitted from the application program to the mobile device to find a form having at least one field into which information is to entered (see ¶ [0008]; ¶ [0012]; ¶ [0013]; ¶ [0031] to ¶ [0039] and ¶ [0043]); retrieving and entering information to enter into the at least one field (see [0023] to [0026] and [0044], Steed) and transmitting the form including the entered information to the mobile device for display to the user (¶ [0008]; ¶ [0012]; ¶ [0026]; ¶ [0031] to ¶ [0039] and ¶ [0043]), the mapping for the form ([0009]).

In related art, Chinn discloses a method for browsing using a limited display device including creating a mapping document for a form (summary and ¶ [0113], Chinn).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Steed to include the claimed feature as taught by Chinn because it would have been desirable to efficiently access content stored on communication networks using limited display devices (¶ [0005], Chinn).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Hanh Thai

July 16, 2008

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